

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Claims 1-18 are currently a part of this application. Claims 19-29 were previously withdrawn.

I. Rejection Under 35 U.S.C. § 102(b)

Claims 1-2, 4-7, 12, and 16-17 are rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by EP 1,245,620 (hereinafter "EP '620"). According to the Examiner, EP '620 discloses a breathable film material comprising a polyolefin resin such as polypropylene which is laminated to a substrate such as a polyolefin nonwoven fabric. The Examiner states that the material is suitable for use in forming waterproofing sheets for roofs and that the film may further comprises additives such as alumina to impart heat and flame resistance. With regard to claim 17, the Examiner stated that claim 17 recites a statement of intended use and does not structurally further limit the structure of claim 1.

Anticipation of a claim under §102 requires that the prior art reference disclose each and every element of the claim to which it is applied. In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). Thus, there must be no differences between the subject matter of the claim and the disclosure of the applied prior art reference. Stated another way, the reference must contain within its four corners adequate direction to practice the invention as claimed. The corollary of the rule is equally applicable: the absence from the applied reference of any claimed element negates anticipation. *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986).

Independent claim 1 has been amended to recite a breathable thermoplastic film or a coated laminate having an MVTR of greater than 20g/m²/day but not less than 500g/m²/day, and

to recite that the substrate is a glass fiber-based substrate, and having a minimum thickness of 2 mils. EP '620 discloses an MVTR of 1000-3000g/cm²/day. Furthermore, EP '620 does not disclose a glass fiber-based substrate as recited in amended claim 1 and does not disclose a film having a minimum thickness of 2 mils when coated over a glass fiber-based substrate.

In view of the amendment to independent claim 1, EP '620 does not teach each and every element of amended independent claim 1 arranged as in the claim, and as such, is not anticipated. Claims 6 and 7 have been canceled by the current amendment and the rejections to these claims are thus moot. Since claims 2, 4, 5, 12 and 16-17 depend directly or indirectly from claim 1, these claims incorporate all the limitations of amended claim 1 and are likewise not anticipated for the same reasons as asserted with regard to claim 1. Reconsideration and withdrawal of this rejection is respectfully requested.

II. Rejections Under 35 U.S.C. § 103

A. Claims 1-2, 4-8, 10 and 17

Claims 1-2, 4-8 10 and 17 are rejected under 35 U.S.C. § 103 as being allegedly unpatentable over WO 9637668 ("WO '668").

Applicants respectfully disagree and request reconsideration of the rejections under 35 U.S.C. §103. For a rejection based on a single reference, obviousness requires that there be some motivation, suggestion, or teaching of the desirability to modify the reference. Additionally, all the claimed limitations must be taught or suggested by the prior art. (*In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974); *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

Initially, Applicant notes that contrary to the statement by the Examiner in the First Office Action and repeated in the present Office Action, the Examiner has not yet provided a

complete translation of the cited PCT application, which Examiner communicated would be forwarded to Applicant. According to MPEP § 706.02:

When an abstract is used to support a rejection, the evidence relied upon is the facts contained in the abstract, not additional facts that may be contained in the underlying full text document. Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art. See *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished). To determine whether both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed. If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. The record must also be clear as to whether the examiner is relying upon the abstract or the full text document to support a rejection....Because all patentability determinations are fact dependent, obtaining and considering full text documents at the earliest practicable time in the examination process will yield the fullest available set of facts upon which to determine patentability, thereby improving quality and reducing pendency.

As such, Applicant can only submit arguments with respect to the English language Abstract of the PCT application. Applicant also submits that without the translation of WO '668, the present Final Rejection is improper under MPEP § 706.07(a) and requests reconsideration.

With all due respect to the Examiner, WO '668 does not disclose the type of substrate utilized in the so-called "air barrier". WO '668 does not recite a non-asphaltic roofing underlayment and does not teach or suggest a breathable thermoplastic film that has a minimal moisture transmission rate of greater than 20g/m²/day or less than 500g/m²/day as recited in amended claim 1.

Additionally, the Examiner asserts that "[W]hile WO '668 does not particularly state the claimed MVTR, since WO '668 teaches employing a permeable or breathable film, it would have been obvious to one of ordinary skill in the art to have selected the desired MVTR through

the process of routine experimentation which had the optimum MVTR. Applicant requests reconsideration and submits that it would not have been obvious to select the MVTR as recited in amended Claim 1. The MVTR recited in claim 1 is optimal for the product of claim 1 but may not be optimal for other similar products and thus the selection of the recited MVTR would not have been obvious to one of ordinary skill in the art.

It has been held by the Courts that to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). WO '668 does not teach a non-asphaltic underlayment as provided for in amended claim 1. Accordingly, Applicants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 1 is improper.

Claims 2, 4-8, 10 and 17 which depend directly or indirectly from claim 1, further define the elements recited in claim 1. Claims 6-8 have been canceled by the current amendment and the rejections to these claims are thus moot. Claims 2, 4, 5, 10 and 17 incorporate all the limitations of claim 1 and it is thus submitted that these claims are likewise allowable for the same reason as set forth with respect to independent claim 1.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of the claims under WO '668, and respectfully request allowance of claims 1, 2, 4-8, 10 and 17.

B. Claims 1-2, 4-7, 10, 13-14, 17 and 18

Claims 1-2, 4-7, 10, 13-14, 17 and 18 are rejected under 35 U.S.C. § 103 as being allegedly unpatentable over U.S. Pat. No. 6,645,336 to Albertone, et al. (" '336 patent").

The '336 patent does not teach a breathable thermoplastic film or laminate coated over a glass fiber based substrate, and more specifically, a breathable non-asphaltic roofing

underlayment including a breathable thermoplastic film or coated laminate having a minimum moisture vapor transmission rate of greater than $20\text{g/m}^2/\text{day}$ or less than $500\text{g/m}^2/\text{day}$ as recited in amended claim 1.

It has been held by the Courts that to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). WO '668 does not teach a non-asphaltic underlayment as provided for in amended claim 1. Accordingly, Applicants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 1 is improper.

Claims 2, 4-7, 10, 13-14, 17 and 18 which depend directly or indirectly from claim 1, further define the elements recited in claim 1. Claims 6 and 7 have been canceled by the current amendment and the rejections to these claims are thus moot. Claims 2, 4, 5, 10, 13-14, 17 and 18 incorporate all the limitations of claim 1 and it is thus submitted that these claims are likewise allowable for the same reason as set forth with respect to independent claim 1.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of the claims under WO '668, and respectfully request allowance of claims 1, 2, 4-7, 10, 13-14, 17 and 18.

C. Claim 9

Claim 9 is rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over EP '620. According to the Examiner, EP '620 discloses a laminate material as set forth above in the rejection under 35 U.S.C. 102(b). The Examiner states that EP '620 differs from the claimed invention because it does not disclose the claimed thickness of the substrate. The Examiner asserts that it would be obvious to one of ordinary skill in the art at the time the invention was

made to select the thickness of the substrate through the process of routine experimentation in order to arrive at a laminate which had the desired strength, weight, breathability, etc.

Claim 9 is a dependent claim that depends directly from independent claim 1 and incorporates all the limitations of claim 1. As discussed in detail above, unlike EP '620 does not recite each and every element as recited in claim 1. As such, claim 9 which incorporates all the limitations of claim 1 is not obvious in view of EP '620 as there is no suggestion or teaching in EP '620 to modify the reference so as to arrive at the invention in claim. 1.

Reconsideration and withdrawal of this rejection is respectfully requested.

D. Claim 3

Claim 3 is rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over each of EP '620, WO '668 (described above) and Albertone (also described above), each in view of U.S. Patent No. 4,511, 619 to Kuhnel et al. (hereinafter "Kuhnel"). Although the Examiner concedes that none of the cited references of EP '620, WO '668 and Albertone teach disposing the film on both sides of the fabric substrate layer, Kuhnel teaches that in forming roofing materials that the film can be disposed on both sides of the fabric so that the fabric can strengthen the film. Accordingly, the Examiner alleges the combination of references teaches the elements of the claim.

Claim 3 is a dependent claim that depends directly from independent claim 1 and incorporates all the limitations of claim 1. As discussed in detail above, EP '620 does not recite each and every element as recited in claim 1. As such, claim 3 which incorporates all the limitations of claim 1 is not obvious in view of EP '620 since EP '620 fails as a primary reference and since there is no teaching or suggestion in EP '620 to or to combine reference teachings so as to arrive at the invention in claim. 1.

Reconsideration and withdrawal of this rejection is respectfully requested.

E. Claims 11 and 15

Claims 11 and 15 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Albertone in view of U.S. Patent No. 6,300,257 to Kirchberger, et al (hereinafter "Kirchberger"). Although the Examiner concedes that Albertone does not disclose that the polymer layer or the tie layer comprises methyl methacrylate, the Examiner alleges that Kirchberger teaches that methyl methacrylate can be added to layers of breathable roofing materials in order to improve the interlaminar bonding strength of layers which contain ethylene copolymers. Therefore, the Examiner alleges the combination of references teaches the elements of the claims.

Claims 11 and 15 are dependent claims that depend directly or indirectly from independent claim 1 and incorporate all the limitations of claim 1. As discussed in detail above, EP '620 does not recite each and every element as recited in claim 1. As such, claim 3 which incorporates all the limitations of claim 1 is not obvious in view of EP '620 since EP '620 fails as a primary reference and since there is no suggestion or teaching in EP '620 to or to combine reference teachings so as to arrive at the invention in claim. 1.

Reconsideration and withdrawal of this rejection is respectfully requested

III. Conclusion

In view of the aforementioned remarks and amendments, the Applicants believe that each of the pending claims is in condition for allowance. If, upon receipt and review of this amendment, the Examiner believes that the present application is not in condition for allowance

Appl. No. 10/702,689
Amdt. dated October 14, 2006
Reply to Office Action of June 14, 2006

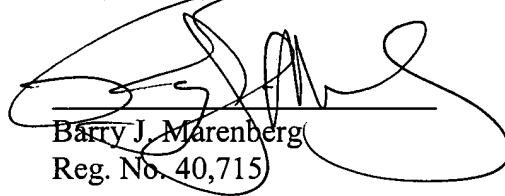
and that changes can be suggested which would place the claims in allowable form, the Examiner is respectfully requested to contact Applicant's undersigned counsel at the number provided below.

Please charge any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 03-1250 (Ref. No. DN2815).

Date: _____

10/16/06

Respectfully submitted,



Barry J. Marenberg
Reg. No. 40,715

Sills Cummis Epstein & Gross PC
One Riverfront Plaza
Newark, New Jersey 07102
Telephone: 973-643-7000
Fax: 973-643-6500